

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 6, 11, 15, 19, 21 and 22 have been amended.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-22 are now pending in this application.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In response, Applicant amends the independent claims to correspond to the invention disclosed in the specification including Application Nos. 10/448,646 and 10/449,555 which are incorporated by reference.

As a preliminary matter, Applicant notes that the Examiner acknowledges that the level of predictability in the computer arts is generally considered predictable. The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. See MPEP § 2164.03. Here, in contrast to the above teachings, the Examiner, while acknowledging the level of predictability in the art is high, incorrectly requires that the specification provide significant guidance and direction.

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166

USPQ 18, 24 (CCPA 1970). Paragraphs [0015]-[0022] and Figs. 2-5 disclose a method for making the invention. In view of the fact that significant guidance in the art is not required and Application Nos. 10/448,646 and 10/449,555 are incorporated by reference, Applicant respectfully traverses the rejection and requests that the rejection be withdrawn.

In the Office Action, the Examiner sets forth several factors in support of the assertion that claims 1-22 fail to comply with the enablement requirement. First, the Examiner states that [e]ssentially all limitations for using a proxy to examine an execution stack to identify the caller of a network service fall within the scope of the claims.” (emphasis added) Applicant respectfully disagrees. The claimed invention is directed to a “method of identifying a message source in a network.” The use of a proxy is neither claimed nor disclosed. The Examiner has inappropriately read unnecessary limitations into the claims in making the rejection.

Second, the Examiner goes on to state that the amount of experimentation required to make use of the invention would be undue because “[a] search of the prior art has not revealed a system as claimed for using a proxy to examine an execution stack to identify the caller of a network service.” Again, the claimed invention is directed to a “method of identifying a message source in a network.” The use of a proxy is neither claimed nor disclosed. The Examiner has inappropriately read unnecessary limitations into the claims in making the rejection.

In the Office Action, the Examiner argues that the “features that Applicant argues distinguish the claims from the prior art are those that are not adequately described.” Specifically, the Examiner asserts that the Applicant argued that the distinguishing feature of the claimed invention is the use of a comparison algorithm on a client server to identify an object on the client computer that is invoking the object on [a] data server but the specification does not adequately describe how this operation occurs. Applicant respectfully disagrees.

Claims 1-22 are enabled by the specification, which includes U.S. Patent Application Nos. 10/448,646 and 10/449,555 which were incorporated by reference on page

1 of the specification. The claimed method recites that a client computer is identified from an execution stack. Paragraph [0017] and Fig. 4 describes how the execution stack is examined. Further, systems and methods for monitoring the activities of a remote system including an execution stack are disclosed in Application Nos. 10/448,646 and 10/449,555 which were incorporated by reference.

Paragraph [0016] specifically recites an algorithm *operable on the client server* for implementing the claimed invention. The code in paragraph [0016] is for illustration purposes only. Systems and methods for monitoring and operating a client/server system are disclosed in Application Nos. 10/448,646 and 10/449,555 which were incorporated by reference. Further, one skilled in the art, e.g., Java programming, given the algorithm in paragraph [0016] would be able to implement the algorithm in a client server environment using any combination of Java technologies including, for example, Java Server Pages, Java Servlets, Java Enterprise Beans and similar technologies.

Further, the Examiner states that the specification does not describe a working example. However, “[c]ompliance with the enablement requirement of 35 U.S.C. 112, first paragraph, does not turn on whether an example is disclosed. Moreover, in view of the amendments and the fact that less information needs to be explicitly stated in the specification because the level of predictability is high, the totality of evidence suggests that it would not require undue experimentation to make and use the claimed invention. Furthermore, with respect to the enablement issues, Applicant notes that the burden is upon the Patent Office to establish that the claims are not enabled. In the present case, the Patent Office has merely asserted that the claims are not enabled based on the present disclosure without providing any evidentiary basis for such an assertion, but for the examiner’s own opinion.

Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 6-9, 15-18, and 21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In response, Applicant has amended claims 6, 15 and 21 to recite an XML message. Accordingly, Applicant requests that the rejection be withdrawn and claims 6-9, 15-18, and 21 be allowed.

Conclusion

Applicant believes that the present application is now in condition for allowance.
Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 C.F.R. § 1.25. Additionally, charge any fees to Deposit Account 08-2025 under 37 C.F.R. § 1.16 through § 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

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